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EXAMINER

HUNTSINGER, PETER K

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/808,289	Applicant(s) IWASE ET AL.	
	Examiner Peter K. Huntsinger	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 51-86 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

2. Claim 63 is objected to because of the following informalities: In claim 63, replace line 5 with "paper sheet in response to the partial print request signal stored in ~~the~~ a storage section, the". Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 51, 52, 57, 58, 63, 64, 69, 74, 75, 78, 83 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No. Yoneda 5,222,157 in view of Vertelney Patent 5,202,828.

Referring to **claim 51**, Yoneda '157 discloses an image forming apparatus comprising:

receiving section (col. 4, lines 3-11, system bus 6 of Fig. 1) configured to receive a plurality of pages of image data transmitted through a communication line (col. 27,

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lines 26-34, a document recorded is retrieved in the retrieving operation) and to receive a partial print request signal requesting that only a part of the image data be printed (col. 17-18, lines 63-68, 1-7, the partial setting of Fig. 12 allows the user to select partial printing of certain pages of the document); and

storage section configured to store the image data and the partial print request-signal, both received at the receiving section (col. 4, lines 26-29, memory section 3 of Fig. 1);

first printing section configured to perform a trial print on a paper sheet, in response to the partial print request signal stored in the storage section (col. 17-18, lines 63-68, 1-7, the partial setting of Fig. 12 allows the user to select partial printing of certain pages of the document); and

second printing section configured to print all pages of the image data stored in the storage section, upon receiving an all-page print instruction after the first printing section has printed the part of the image data (see Fig. 11, the document can be printed and then printed again), said all-page print instruction demanding that the image data be printed in a specific fashion (col. 17-18, lines 63-68, 1-7, the all setting of Fig. 12 causes [i.e. demands] all the contents of the corresponding document to be printed).

Yoneda '157 does not disclose expressly printing a sentence or mark indicating that the trial print.

Vertelney '828 discloses printing a sentence or a mark on a paper sheet in response to the partial print request signal stored in the storage section, the sentence or the mark indicating that the trial print is the printing of the part of the image data (col. 8,

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lines 64-67, documents marked with the Draft element 56 would only print with the word "draft" written across each page).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to print a draft mark on a trial print. The motivation for doing so would have been to notify the user that a printed document is a draft. Therefore, it would have been obvious to combine Vertelney '828 with Yoneda '157 to obtain the invention as specified in claim 51.

Referring to **claims 52, 58 and 64**, Yoneda '157 discloses wherein the second printing section receives the all-page print instruction from a user through a control panel provided on the image forming apparatus (col. 17-18, lines 63-68, 1-7, condition display panel 117 of Fig. 12 includes the all setting which causes all the contents of the corresponding document to be printed).

Referring to **claims 57 and 63**, Yoneda '157 discloses an image forming apparatus comprising:

receiving section (col. 4, lines 3-11, system bus 6 of Fig. 1) configured to receive a plurality of pages of image data transmitted through a communication line (col. 27, lines 26-34, a document recorded is retrieved in the retrieving operation) and to receive a partial print request signal requesting that only a part of the image data be printed (col. 17-18, lines 63-68, 1-7, the partial setting of Fig. 12 allows the user to select partial printing of certain pages of the document); and

first printing section configured to perform a trial print on a paper sheet, in response to the partial print request signal stored in the storage section (col. 17-18,

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lines 63-68, 1-7, the partial setting of Fig. 12 allows the user to select partial printing of certain pages of the document); and

second printing section configured to print all pages of the image data stored in the storage section, upon receiving an all-page print instruction after the first printing section has printed the part of the image data (see Fig. 11, the document can be printed and then printed again), said all-page print instruction demanding that the image data be printed in a specific fashion (col. 17-18, lines 63-68, 1-7, the all setting of Fig. 12 causes [i.e. demands] all the contents of the corresponding document to be printed).

Yoneda '157 does not disclose expressly printing a sentence or mark indicating that the trial print.

Vertelney '828 discloses printing a sentence or a mark on a paper sheet in response to the partial print request signal stored in the storage section, the sentence or the mark indicating that the trial print is the printing of the part of the image data (col. 8, lines 64-67, documents marked with the Draft element 56 would only print with the word "draft" written across each page).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to print a draft mark on a trial print. The motivation for doing so would have been to notify the user that a printed document is a draft. Therefore, it would have been obvious to combine Vertelney '828 with Yoneda '157 to obtain the invention as specified in claim 57.

Referring to **claim 69**, Yoneda '157 discloses an image forming method comprising:

receiving at an image forming apparatus, a plurality of pages of image data (col. 27, lines 26-34, a document recorded is retrieved in the retrieving operation), a print setting data for the plurality of pages of image data (col. 15, lines 6-15, the condition display 117 of Figs. 11 and 12 allow for selecting settings for the printed document), a trial print request signal requesting that only a part of the image data be printed (col. 17-18, lines 63-68, 1-7, the partial setting of Fig. 12 allows the user to select partial printing of certain pages of the document), and a trial print page indicating a page of the plurality of pages of image data be printed for the trial print (col. 17-18, lines 63-68, 1-7, the partial setting of Fig. 12 allows the user to select partial printing of certain pages of the document), which are transmitted through a communication line at an image forming apparatus (col. 4, lines 3-11, system bus 6 of Fig. 1);

receiving a trial print instruction at an operational panel of the image forming apparatus (col. 17-18, lines 63-68, 1-7, the partial setting of Fig. 12 allows the user to select partial printing of certain pages of the document);

printing on a paper sheet at the image forming apparatus upon receiving the trial print instruction, the page of the image data according to the trial print page (col. 17-18, lines 63-68, 1-7, the partial setting of Fig. 12 allows the user to select partial printing of certain pages of the document);

receiving a change of the print setting at the operational panel of the image forming apparatus (col. 15, lines 6-15, the condition display 117 of Figs. 11 and 12 allow for selecting settings for the printed document);

receiving an all-page print instruction at the operational panel of the image forming apparatus (col. 17-18, lines 63-68, 1-7, the all setting of Fig. 12 causes all the contents of the corresponding document to be printed); and

printing all pages of the image data with the changed print setting upon receiving the all-page print instruction after the trial print (see Fig. 11, the document can be printed and then printed again).

Yoneda '157 does not disclose expressly printing a sentence or mark indicating that the trial print.

Vertelney '828 discloses printing a sentence or a mark indicating that the sheet is printed for trial print (col. 8, lines 64-67, documents marked with the Draft element 56 would only print with the word "draft" written across each page).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to print a draft mark on a trial print. The motivation for doing so would have been to notify the user that a printed document is a draft. Therefore, it would have been obvious to combine Vertelney '828 with Yoneda '157 to obtain the invention as specified in claim 69.

Referring to **claims 74 and 83**, Yoneda '157 discloses the print setting data is a double-sided print or not double-side print (col. 16, lines 48-55, When "RADF" is selected, the item 113 of Fig. 11 is used to select either a "single side" mode (single-side read) for inputting only single-side data of a document sheet or a "double side" mode (double-side read) for inputting double-side data of a document sheet. The default setting is "one side").

Referring to **claims 75 and 84**, Yoneda '157 discloses the print setting is number of copies (col. 18, lines 8-12, An item 132 of Fig. 12 is used to designate the number of copies of a document to be output. Although the default setting is "one copy", "multiple copies" can be selected to output a desired number of copies which is input through the ten-key pad 129).

Referring to **claim 78**, Yoneda '157 discloses an image forming apparatus comprising:

a first receiving section (col. 4, lines 3-11, system bus 6 of Fig. 1) receiving, a plurality of pages of image data (col. 27, lines 26-34, a document recorded is retrieved in the retrieving operation), a print setting data for the plurality of pages of image data (col. 15, lines 6-15, the condition display 117 of Figs. 11 and 12 allow for selecting settings for the printed document), a trial print request signal requesting that only a part of the image data be printed (col. 17-18, lines 63-68, 1-7, the partial setting of Fig. 12 allows the user to select partial printing of certain pages of the document), and a trial print page indicating a page of the plurality of pages of image data be printed for the trial print (col. 17-18, lines 63-68, 1-7, the partial setting of Fig. 12 allows the user to select partial printing of certain pages of the document), which are transmitted through a communication line (col. 4, lines 3-11, system bus 6 of Fig. 1);

a second receiving section receiving a trial print instruction at an operational panel of the image forming apparatus (col. 17-18, lines 63-68, 1-7, the partial setting of Fig. 12 allows the user to select partial printing of certain pages of the document);

a printing section printing on a paper sheet upon receiving the trial print instruction (col. 17-18, lines 63-68, 1-7, the partial setting of Fig. 12 allows the user to select partial printing of certain pages of the document);

a third receiving section receiving a change of the print setting at the operational panel of the image forming apparatus (col. 15, lines 6-15, the condition display 117 of Figs. 11 and 12 allow for selecting settings for the printed document);

a fourth receiving section receiving an all-page print instruction at the operational panel of the image forming apparatus (col. 17-18, lines 63-68, 1-7, the all setting of Fig. 12 causes all the contents of the corresponding document to be printed);; and

the printing section printing all pages of the image data with the changed print setting upon receiving the all-page print instruction after the trial print (see Fig. 11, the document can be printed and then printed again).

Yoneda '157 does not disclose expressly printing a sentence or mark indicating that the trial print.

Vertelney '828 discloses printing the page of the image data according to the trial print page and a sentence or a mark indicating that the sheet is printed for trial print (col. 8, lines 64-67, documents marked with the Draft element 56 would only print with the word "draft" written across each page).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to print a draft mark on a trial print. The motivation for doing so would have been to notify the user that a printed document is a draft. Therefore, it would have been

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obvious to combine Vertelney '828 with Yoneda '157 to obtain the invention as specified in claim 78.

5. Claims 53, 54, 59, 60, 65 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneda Patent 5,222,157 and Vertelney Patent 5,202,828 as applied to claims 51, 57 and 63 above, in further view of Wood Patent No. 6,453,127.

Referring to **claims 53, 59 and 65**, Yoneda '157 discloses wherein the image forming apparatus is adapted to receive the partial print request signal from an image forming apparatus having a window providing a check button adapted to designate a pre-print display mode of trial printing (col. 17-18, lines 63-68, 1-7, condition display panel 117 of Fig. 12 the partial setting which allows the user to select partial printing of certain pages of the document).

Yoneda '157 does not disclose expressly receiving the print request from a personal computer.

Wood '127 discloses receiving the print request from a personal computer (col. 2, lines 5-17, user interface allows the computer to communicate print job to copier);

At the time of the invention, it would have obvious to a person of ordinary skill in the art for a printer to receive a print command from a PC. The motivation for doing so would have been to enable printing computer based data. Therefore, it would have been obvious to combine Wood '127 with Yoneda '157 to obtain the invention as specified in claim 53.

Referring to **claims 54, 60 and 66**, Yoneda '157 discloses the second printing section is configured to print all pages of image data, but does not disclose transferring data representing the specific fashion to a data processing device.

Wood '127 discloses a transfer section configured to transfer data representing the specific fashion to a data processing device which has transmitted the image data to the image forming apparatus through the communication line, after printing image data (col. 6, lines 18-34, the UIS provides data through the thread and socket connection to the work station 11 for the next user interface screen of Fig. 4).

At the time of the invention, it would have obvious to a person of ordinary skill in the art for a printer to control a printer from a PC. The motivation for doing so would have been to enable printing computer based data. Therefore, it would have been obvious to combine Wood '127 with Yoneda '157 to obtain the invention as specified in claim 54.

6. Claims 55, 56, 61, 62, 67 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneda Patent 5,222,157 and Vertelney Patent 5,202,828 as applied to claims 51, 57 and 63 above, in further view of Silverbrook Patent 5,984,446.

Referring to **claims 55, 61 and 67**, Yoneda '157 discloses wherein: the first printing section is adapted to print the part of the image data stored in the storage section (col. 17-18, lines 63-68, 1-7, the partial setting of Fig. 12 allows the user to select partial printing of certain pages of the document); and

the second printing section is adapted to print all pages of the image data stored in the storage section, upon receiving an all-page print instruction from the user through the control panel provided on the image forming apparatus, after the first printing section has printed the part of the image data (col. 17-18, lines 63-68, 1-7, the all setting of Fig. 12 causes [i.e. demands] all the contents of the corresponding document to be printed).

Yoneda '157 does not disclose expressly printing in color.

Silverbrook '446 discloses printing in color (col. 6, lines 16-32, color copiers are used).

At the time of the invention, it would have obvious to a person of ordinary skill in the art for a copier to print in color. The motivation for doing so would have been to enable printing more expressive documents. Therefore, it would have been obvious to combine Silverbrook '446 with Yoneda '157 to obtain the invention as specified in claim 55.

Referring to **claims 56, 62 and 68**, Yoneda '157 discloses wherein: the first printing section is adapted to print the part of the image data in response to the partial print request signal stored in the storage section, upon receiving a partial print instruction from the user through the control panel provided on the image forming apparatus printing (col. 17-18, lines 63-68, 1-7, condition display panel 117 of Fig. 12 the partial setting which allows the user to select partial printing of certain pages of the document).

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Silverbrook '446 discloses a color print instruction (col. 6, lines 16-32, color copiers are used).

7. Claims 70 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneda Patent 5,222,157 and Vertelney Patent 5,202,828 as applied to claims 69 and 78 above, in further view of Naito Patent 4,821,107.

Referring to **claims 70 and 79**, Yoneda '157 discloses the print setting data, but does not disclose expressly wherein the setting is a density.

Naito '107 discloses a density button configured to, when user selected, set the print density information (print density designation keys 44c of Fig. 9, col. 6, lines 9-18).

At the time of the invention, it would have obvious to a person of ordinary Skill in the art to allow the user to set print density information. The motivation for doing so would have been to allow the user to print darker or lighter documents. Therefore, it would have been obvious to combine Naito '107 with Yoneda '157 to obtain the invention as specified in claims 70 and 79.

8. Claims 71 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneda Patent 5,222,157 and Vertelney Patent 5,202,828 as applied to claims 69 and 78 above, in further view of Oshio Patent 5,279,218.

Referring to **claims 71 and 80**, Yoneda '157 discloses the print setting data, but does not disclose expressly wherein the print setting data is a sort or not sort.

Oshio '218 discloses wherein the print setting data is a sort or not sort (col. 52-59, Upon every depression of a rectangular mode change-over key 11a as shown on the righthand side in FIG. 3, the lighting of three mode displays (e.g., LEDs) 11b, 11c, 11d as shown on the lefthand side in FIG. 3 and corresponding to the "sort", "non-sort" and "sequence" modes, respectively, will be switched orderly one to another so that the user can observe the current status of the sorting).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to include a sort print setting option. The motivation for doing so would have been to allow the user to customize a printed document according to sorting. Therefore, it would have been obvious to combine Oshio '218 with Yoneda '157 to obtain the invention as specified in claims 71 and 80.

9. Claims 72, 73, 81 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneda Patent 5,222,157 and Vertelney Patent 5,202,828 as applied to claims 69 and 78 above, in further view of Tabata Patent 5,602,651.

Referring to **claims 72 and 81**, Yoneda '157 discloses the print setting data, but does not disclose expressly wherein the print setting data is a staple or not staple.

Tabata '651 discloses wherein the print setting data is a staple or not staple (Fig. 13a, col. 20, lines 46-67, LCD section 2403 is used as a staple position input means for inputting a staple position for binding a bundle of recording paper 2215).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to include a staple setting option. The motivation for doing so would have been

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to allow the user to customize a printed document according to stapling. Therefore, it would have been obvious to combine Tabata '651 with Yoneda '157 to obtain the invention as specified in claims 72 and 81.

Referring to **claims 73 and 82**, Tabata '651 discloses wherein the print setting data is a staple position (Fig. 13a, col. 20, lines 46-67, LCD section 2403 is used as a staple position input means for inputting a staple position for binding a bundle of recording paper 2215).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to include a staple setting option. The motivation for doing so would have been to allow the user to customize a printed document according to stapling. Therefore, it would have been obvious to combine Tabata '651 with Yoneda '157 to obtain the invention as specified in claims 73 and 82.

10. Claims 76, 77, 85 and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneda Patent 5,222,157 and Vertelney Patent 5,202,828 as applied to claims 69 and 78 above, in further view of Narendranath Patent 5,751,433.

Referring to **claims 76 and 85**, Yoneda '157 discloses the print setting data, but does not disclose expressly wherein the print setting data is a color saturation.

Narendranath '433 discloses the print setting data is a color saturation (col. 8, lines 25-55, when the "Variable Color Draft" mode button 164 is selected, a subsequent user interface screen such as shown in FIG. 4 appears, wherein a user may variably alter the maximum density of the TRC for the black separation (slide control 164a), the

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cyan separation (slide control 164b); the magenta separation (164C) and/or the yellow separation (164d)).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to include a color saturation setting option. The motivation for doing so would have been to allow the user to customize a printed document according to color preferences. Therefore, it would have been obvious to combine Narendranath '433 with Yoneda '157 to obtain the invention as specified in claims 76 and 85.

Referring to **claims 77 and 86**, Yoneda '157 discloses the print setting data, but does not disclose expressly wherein the print setting data is a color balance.

Narendranath '433 discloses the print setting data is a color balance (col. 8, lines 25-55, when the "Variable Color Draft" mode button 164 is selected, a subsequent user interface screen such as shown in FIG. 4 appears, wherein a user may variably alter the maximum density of the TRC for the black separation (slide control 164a), the cyan separation (slide control 164b); the magenta separation (164C) and/or the yellow separation (164d)).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to include a color balance setting option. The motivation for doing so would have been to allow the user to customize a printed document according to color preferences. Therefore, it would have been obvious to combine Narendranath '433 with Yoneda '157 to obtain the invention as specified in claims 76 and 85.

Conclusion

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11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter K. Huntsinger/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625